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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/621,384

07/18/2003

Tom Griffin

STAR-1P1

2452

23599

7590

07/29/2004

EXAMINER

SMITH, RICHARD A

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.  
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ARLINGTON, VA 22201

ART UNIT

PAPER NUMBER

2859

DATE MAILED: 07/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/621,384	<b>Applicant(s)</b> GRIFFIN, TOM	
	<b>Examiner</b> R. Alexander Smith	<b>Art Unit</b> 2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16-20 is/are rejected.
- 7) ☒ Claim(s) 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of: \_\_\_\_\_
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 are rejected under 35 U.S.C. 102(b) as being unpatentable over U.S. 5,494,735 to Nitta.

Nitta discloses a pennant (figures 3-5) having a first layer (the uppermost B) having a front surface on which a display design (the uppermost 9) occurs and a back surface, a second layer (the lowermost B) having a rear surface on which pennant information (the lowermost 9) occurs, the second layer having a front surface facing the back surface of the first layer, and a stiffener layer (A) disposed between the first and second layers, the stiffener layer being adhered via bonding to the first and second layers, the stiffener layer being a woven polyester (starting column 3, line 63).

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being unpatentable over U.S. 5,256,490 to Pierce.

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Pierce discloses a pennant having a first layer (11) having a front surface on which a display design (i.e., a logo) occurs and a back surface, a second layer having a rear surface on which pennant information (i.e., the Olympic rings) occurs, the second layer (12) having a front surface facing the back surface of the first layer, and a stiffener layer (13-16) disposed between the first and second layers, the stiffener layer being adhered to the first and second layers, the first and second layers can include woven, knitted, and non-woven synthetic fibers, natural fibers, fabrics and paper (column 2, lines 4-11), the stiffening layer being polyester (column 12-14, i.e., a film layer of PET), the decorative area being applied as a sublimation or a transfer (sublimation is a type of transfer), any indication on the back surface of the first layer being covered by the stiffener layer so as not to be discernable in the second layer visually, data fixed to the back surface, at least a first layer in the shape of the pennant.

With respect to the stiffener layer: Pierce discloses that the stiffener layer is intended to be flexible in order to exhibit a "fly" quality. Pierce also discloses that this stiffener layer includes a polyester layer combined with a metal layer and that type of polyester, i.e., clear, white or black, and the thickness of the metal layer, i.e., aluminum, may be varied depending on the degree of opaqueness desired. Since the claim does not disclose the degree of stiffness, the stiffener layer, as disclosed by Pierce, meets the structural limitations in the claim.

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### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nitta in view of U.S. 5,256,490 to Pierce.

Nitta teaches all that is claimed as discussed in the above rejections of claim 1 except for the limitations of claim 2.

Pierce discloses a pennant having first and second layers that can include woven, knitted, and non-woven synthetic fibers, natural fibers, fabrics and paper (column 2, lines 4-11).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to replace the materials of the first and second layers, taught by Nitta, with the materials, as taught by Pierce, in order to provide pennants having different aesthetic appeal and appearances.

With respect to the applicant's limitations of claim 2, i.e., the material being of polyester felt, wool, polyamide, wool blend, leather, cotton and silk, are considered equivalent to the materials disclosed by Pierce, since the materials claimed by applicant are subsets of the materials disclosed by Pierce.

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6. Claims 2, 3 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce.

Pierce teaches all that is claimed as discussed in the above rejections of claim 1 except for the limitations of claims 2, 3 and 13.

With respect to claims 2 and 3: Pierce discloses that the first and second layers can include woven, knitted, and non-woven synthetic fibers, natural fibers, fabrics and paper (column 2, lines 4-11). The applicant's limitations of claims 2 and 3, i.e., the material being of polyester felt, wool, polyamide, wool blend, leather, cotton and silk, are considered equivalent to the materials disclosed by Pierce, since the materials claimed by applicant are subsets of the materials disclosed by Pierce.

With respect to claims 3: Pierce discloses that the stiffening layer includes a polyester film of polyethylene terephthalate, i.e., Mylar which is a Dupont product, and discloses a variety of materials for the first layers which can include woven, knitted, and non-woven synthetic fibers, natural fibers, fabrics and paper. Furthermore, it is very well known that Dupont provides polyethylene terephthalate in a variety of forms, one of which is the film called Mylar, and another of which is called Dacron, a version of polyethylene terephthalate which is generally used in woven form. Each having particular strengths and weaknesses, Mylar's being, amongst others, air resistant, water resistant, very high flexibility, thermoplastic but very poor sheer resistance once torn or punctured. Dacron's being, amongst others, good flexibility, weaveable, very high sheer resistance (at least relative to Mylar), thermoplastic but poor air and water resistance. It would be obvious that the choice of materials for the stiffening layer as being merely manufacturing choices based on the preferences of the user or manufacturer. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to use a woven polyester as claimed with the stiffening layer, taught by Pierce, based on preferences of a user or manufacturer. In this case, if the user or manufacturer intends for the pennant to be hung rather than flown.

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With respect to claim 13, i.e, the pennant having a V-shaped bifurcated apex with two projecting points: these shape is only considered to be an obvious modification of a shape of a pennant because the courts have held that a change in shape or configuration is within the level of skill in the art as the particular shape claimed by Applicant is nothing more than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide, In re Dailey, 149 USPQ 47 (CCPA 1976), and since this shape is a well-known design for pennants.

7. Claims 4-8 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce in view of U.S. 5,840,408 to Giansetto and U.S. 1,467,680 to Oda.

Pierce teaches all that is claimed as discussed in the above rejections of claim 1 except for the at least one decorative area as a direct embroidery, an embroidered applique, the display being a photographic image on a patch and the patch [hereinafter applique] being embroidered around the periphery thereof to the first layer and stitching comprising embroidery around the applique, the display design being a photographic image on an applique and having a peripheral area with stitching, any indication on the back surface not being discernable in the second layer tactically, embroidery behind the first layer and the limitations of claim 20.

Giansetto discloses that embroidery may be applied directly or as an applique fixed with an adhesive, that it can be printed, hand-made or computer controlled. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use direct embroidery, an embroidered applique, as taught by Giansetto, and to fix data on labels stitched or adhered, as suggested by Giansetto, to the pennant, taught by Pierce, in order to affix image and data directly to the pennant in order to personalize the pennant for a particular user. Furthermore, it would

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have been obvious to use a computer, as taught by Giansetto, on the pennant, taught by Pierce, in order to apply the desired personalized image and data desired quickly, cheaply and with consistency.

Oda discloses that a photographic image can be attached to a flag by means of a pocket wherein said attachment includes stitching around a periphery of the photographic image. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add the image and the stitching around the periphery, as suggested by Oda, in order to convey a particular message such as the user's favorite team and player.

With respect to claims 5 and 16, and the display being an photographic image being on an applique and embroidered around the periphery: It would be obvious to embroider a photograph image on an applique, taught by Pierce, as suggested by Giansetto and Oda, as being merely manufacturing choices based on the preferences of the user or manufacturer in order to personalize a pennant and convey a message desired by a user of the pennant, e.g., his favorite player or his pet dog. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to embroider a photograph image on the applique, as claimed, with the pennant, taught by Pierce as modified by Giansetto and Oda, based on preferences of a user or manufacturer to personalize the pennant.

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With respect the applique being embroidered around the perimeter to the pennant and wherein the stitching comprises the embroidery around the applique passing through the periphery: Giansetto discloses appliques being applied using adhesives. Oda discloses that stitching can be used to attach appliques, etc. Therefore, the use of a particular type of attachment means, i.e., embroidered, as claimed by Applicant, is considered to be nothing more



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than the use of one of numerous and well known alternate types of attachment means that a person having ordinary skill in the art would have been able to provide using routine experimentation in order to attach an applique to a pennant as already suggested by Giansetto and by Oda. In this case in order to provide a ornamental and atheistically pleasing stitch which accents the contents of the applique.

With respect to claim 6 and the stitching not being discernable tactically: It would be obvious with respect to the stitching not being discernable tactically as being merely manufacturing choices based on the preferences of the user or manufacturer. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to make the stitching undiscernible tactically as claimed with the pennant, taught by Pierce, based on preferences of a user or manufacturer. In this case, to provide the rear surface of the second layer with the pennant information such that the information, i.e., the Olympic logo, is atheistically and physically pleasing without imperfections being noticeable by sight or touch, i.e., quality construction.

With respect to claim 20, i.e., wherein the applique has a size and shape that covers substantially the entire front surface of the first layer: the size and shape of the applique substantially covering the entire front surface, absent any criticality, is only considered to be an obvious modification of an applique because the courts have held that a change in shape or configuration, without any criticality, is within the level of skill in the art as the particular shape claimed by Applicant is nothing more than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide. In re Dailey, 149 USPQ 47 (CCPA 1976). In this

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case to provide the most noticeable and pleasing view to the potential buyer or the viewer that can fit on the substrate which in this case is the entire front surface.

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce and Giansetto as applied to claims 4-8 and 16-20 above, and further in view of U.S. 6,082,774 to Schlauch.

Pierce and Giansetto together teach all that is claimed as discussed in the above rejections of claims 4-8 and 16-20 except for the data including authenticity data and series data.

Schlauch discloses that collector-targeted memorabilia includes authenticity data and series data in order to enhance the attractiveness of the memorabilia. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to add the authenticity data and series data, as taught by Schlauch, to the pennant, taught by Pierce and Giansetto, in order to enhance the attractiveness of the pennant.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce in view of U.S. D369,042 to Kinart.

Pierce teaches all that is claimed as discussed in the above rejections of claim 1 except for the limitations of claim 10.

Kinart discloses a triangular frame comprising a backing and three frame members (integrally formed), the three frame members comprising a base and two side members. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to add the frame, as taught by Kinart, to the pennant, taught by Pierce, in order to display the pennant while protecting the pennant from the observers and the environment.

10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce and Kinart, as applied to claim 10 above, and further in view of U.S. D267,686 to Dawson.

Pierce and Kinart together teach all that is claimed as discussed in the above rejections of claim 10 except for the limitations of claim 11.

With respect to the pennant being triangular with a base and two sides which define two base angles and an apex angle where joined: Official notice is taken with respect to the pennant being triangular with a base and two sides which define two base angles and an apex angle where joined since this is a very common shape used for pennants, as suggested by the triangular frame disclosed by Kinart for a pennant.

Dawson discloses a triangular frame for a triangularly folded flag wherein the frame has three miter joints which are bifurcated relative to each of the angles of the triangular frame. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the frame, taught by Pierce and Kinart, by adding frame members having miter joints which are bifurcated relative to the each of the triangular frame, as taught by Dawson, in order to provide an aesthetically attractive frame and also since a bifurcated miter joint is commonly used on frame members of quality framing.

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With respect to the bifurcated angles of the frame extending at bifurcated angles of the pennant: the limitation regarding the bifurcated angles being equivalent is only considered to be the "optimum" values of the angles of the frame disclosed by Dawson, as stated above, that a person having ordinary skill in the art would have been able to determine using routine experimentation based, among other things, on providing a triangular frame which has

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dimensions which are proportional to the triangular dimensions of the pennant which provides an atheistically attractive display. See In re Boesch, 205 USPQ 215 (CCPA 1980).

11. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce, Kinart and Dawson, as applied to claim 11 above, and further in view of U.S. 4,879,145 to McLellan et al.

Pierce, Kinart and Dawson together teach all that is claimed as discussed in the above rejection of claim 11 except for the backing being transparent.

McLellan et al. discloses a triangular frame having a base and two sides, said frame also has a backing (26) which is transparent in order to view the contained flag from both sides, i.e, front and back. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to make the backing, taught by Pierce, Kinart, Dawson, transparent, as taught by McLellan et al., in order to view the pennant from both sides.

12. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce in view of D335,784 to Guilfoil, Sr.

Pierce teaches all that is claimed as discussed in the above rejections of claim 1 except for the pennant in combination with a rectangular frame having a backing and four frame members.

Guilfoil, Sr. discloses a flag in combination with a rectangular frame having a backing and four frame members. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to add the frame with the features, as taught by Guilfoil, Sr., to the

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pennant, taught by Pierce, in order to accent the pennant and to display that the pennant is important to the owner.

*Allowable Subject Matter*

13. Claim 15 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims.

14. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

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*Conclusion*

15. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The prior art cited in PTO-892 and not mentioned above disclose related pennants.

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16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. Alexander Smith whose telephone number is 571-272-2251.

The examiner can normally be reached on Monday through Friday from 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F. Gutierrez can be reached on 571-272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'R. Alexander Smith', is positioned above the printed name and title.

R. Alexander Smith  
Examiner  
Technology Center 2800

RAS  
July 26, 2004